

Application No. 09/893,480

### **REMARKS**

Applicants have carefully considered the rejections of the Examiner in the present application. In light of this consideration, Applicants believe that the claims, as now amended, are allowable. Applicants respectfully request reconsideration of the rejection of the claims now pending in the application.

In this first Office Action of January 25, 2005, claims 8 and 14-18, are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,459,819, to Watkins et al. (hereinafter Watkins). Claims 1-7, 9, and 19-21 are rejected under 35 U.S.C. §103(a) as being obvious over Watkins. Claims 10-13 are rejected under 35 U.S.C. §103(a) as being obvious over Watkins in view of the Applicants' cited prior art.

Watkins teaches a system and method for combining a first digital generated image and one or more prestored digital images. The system include means for selecting one of the prestored digital images for and the steps of selecting an output format for printing the first digital generated image and the selected prestored image, providing the first digital generated image, combining the first digital generated image with the selected prestored digital image such that the generated image is placed in the predetermined location so as to form a merged image in accordance with the requirements of the selected output format, and for printing out the merged image in a desired format.

It is clear from the teachings provided in Watkins that the system provided therein is to allow ready manipulation of *pictorial* images. What limited accommodation for text based information made by Watkins is only as entered by the user into the CPU driving the output devices (column 9, lines 42-44). *Nowhere* in Watkins is it mentioned, nor is there any teaching directed to, receiving *text* data into a CPU as input from a portable memory device - let alone into a printing apparatus as claimed by the Applicants. Nowhere in Watkins is there mention of text field entry selection, or indeed delimited text fields; or text parameters; or the selection of text parameters, as is claimed by the Applicants.

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Given that Watkins is assigned to Kodak, and that Kodak's interests are to their digital photography kiosks, this is not a surprising result. The Applicants' teachings however, are directed to a printing apparatus which will among other things allow a businessman to approach with a PDA (personal digital assistant) and generate business cards. Different problems with different solutions.

No additional fee is believed to be required for this amendment; however, the undersigned Xerox Corporation attorney authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025.

It is respectfully submitted that the present set of claims, particularly as now amended, are patentably distinct over the cited references. In the event the Examiner considers personal contact advantageous to the disposition of this case, he is hereby requested to call the undersigned attorney at (585) 423-6918, Rochester, NY.

Respectfully submitted,



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